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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : **09/502212**  
Applicant : **Gawler**  
Filing date : **February 11, 2000**  
Title : **Accounting for Postal Charges**  
TC/A.U. : **2761**  
Examiner : **Vig**  
Docket No. : **4747**  
Customer No. : **26936**

CERTIFICATE OF MAILING

Deposit Date: March 23, 2005

I certify that this correspondence is being deposited with the United States Postal Service with sufficient postage for first class mail service, under 37 C.F.R. §1.8, on the date indicated above, addressed to: U.S. Patent and Trademark Office, Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

*Robyn Fallow*  
Robyn S. Fallow

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Alexandria, Virginia 22313-1450

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT BRIEF**

Sir:

We enclose complete new brief in response to the Notice dated Mar. 10, 2005. The Notification states that the "Current status of claims are not clearly identified in the claims listed in the Appeal Brief". Attention is directed to MPEP 1206, which states that the claim listing should be a clean copy without markings. Therefore, we have amended the STATUS OF CLAIMS section at page 2 to confirm that claims 1 - 13 were canceled.

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March 23, 2005



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,212	02/11/2000	David Anthony Gawler	4747	4884
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SHOEMAKER AND MATTARE, LTD. 10 POST OFFICE ROAD - SUITE 110 SILVER SPRING, MD 20910			ART UNIT	PAPER NUMBER

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

R E C E I V E D  
MAR 11 2005  
SHOEMAKER & MATTARE, LTD.

**Notification of Non-Compliant Appeal Brief  
(37 CFR 41.37)**

	Application No. 09/502,212	Applicant(s) GAWLER, DAVID ANTHONY
	Examiner Naresh Vig	Art Unit 3629

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 03 January 2005 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file a complete new brief in compliance with 37 CFR 41.37 within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1.  The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2.  The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3.  At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4.  (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5.  The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi))
6.  The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7.  The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8.  The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9.  The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10.  Other (including any explanation in support of the above items):

Current status of claims are not clearly identified in the claims listed in the Appeal Brief.

*Naresh Vig*  
Patent Examiner  
3/5/2005



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*Robyn S. Fallow*  
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**APPELLANTS' BRIEF ON APPEAL TO**  
**THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Sir:

This is appellant's brief on appeal to the Board of Patent Appeals and Interferences, from the final rejection of claims 14 - 26 of the application identified above.

**REAL PARTY IN INTEREST**

The owner of this application is Neopost Limited, a corporation, by an assignment recorded at reel 011668, frame 0169.

## RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

## STATUS OF CLAIMS

Claims 1 - 13 have been canceled. Rejected claims 14 - 26 are now at issue. Those claims, as most recently amended, are reproduced in the appendix of this brief.

## STATUS OF AMENDMENTS

All amendments have been entered.

## SUMMARY OF THE INVENTION

The claimed invention requires the provision of an accumulated pending value of postage dispensed in applying postage charges to mail items of any uncompleted batches of mail items, and that accumulated pending value to be decremented by a value of postage relating to one completed batch of mail items on completion of that one batch of mail items.

## ISSUES

The issue on appeal is whether claims 14 - 26 would have been obvious, to a person of ordinary skill in the art, from *Herring* (U.S. Patent 6,064,992) in view of the *DirectTV* article.

## GROUPING OF CLAIMS

Claims 14 - 22 stand or fall together. Claims 23 - 26 stand or fall together.

## ARGUMENT

Claims 14 and 23 would not have been obvious, to a person of ordinary skill in the field of the invention, at the time the invention was made, over *Herring* in view of *DirecTV*.

*Herring* discloses a method and apparatus which provides for storing an accumulated aggregate value of postage dispensed in applying postage charges to mail items. As the examiner acknowledged, *Herring* fails to disclose or suggest the second step of claim 14: "storing an accumulated pending value of postage dispensed in applying postage charges to mail items of any uncompleted batches of mail items".

The *DirecTV* reference discloses a subscription satellite TV service in which programming purchase information is downloaded nightly from the satellite receiver of each subscriber.

The information which is downloaded nightly in the *DirecTV* process is not analogous to a batch of mail items as required by the claimed invention.

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); and *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992)

First, the *DirecTV* reference is not in the same field as applicant's endeavor: the field of subscription TV services is entirely unrelated to the postage metering field.

Second, a person ordinarily skilled in the art would not have contemplated the

referenced teaching of *DirecTV*, in providing for the nightly downloading of purchased programming, to have been reasonably pertinent to the particular problem with which the present inventor was concerned.

The Examiner reasoned that a person skilled in the art would have been motivated to modify the method and apparatus of *Herring* "...to minimize system load by minimizing access to accounting information every time a consumer consumes a product...". The referenced "product" is presumed to be postage charge.

Such reasoning is actually contrary to the teaching of *Herring*, whose method and apparatus essentially require that, each time a franking operation is performed, the postage charge which is dispensed in the franking operation be accounted for.

Even if it were proper to combine the references, they would not lead to the invention now claimed. It is not enough for plural references to disclose various elements of a claim. "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976).

A person skilled in the art would not have had any motivation to modify *Herring* by implementing the teaching of *DirecTV*. This is particularly so in view of the fact that *Herring* is not directed in any way to the processing of batches of mail items. Absent any teaching in *Herring* to the processing of batches of mail items, and *DirecTV* having been introduced only to address a feature relating to the processing of batches of mail items, it is submitted that the combination of features from those two references, so as to arrive at the invention of claims 14 and 23, is not suggested by the art. The combination could only be reached using impermissible hindsight analysis of the prior art, i.e., with knowledge of the present invention.

The references do not suggest that the accounting in respect of the franking operations which are performed in a given period, for example, over a one-day period, be deferred until the end of the period, so as to avoid unnecessary accounting functions at times when the method and apparatus of *Herring* may be under greatest load.

Firstly, deferral of the accounting is not possible, as, insofar as the user of the method and apparatus of *Herring* is required to make payment for the dispensed postage charge, the only way that the dispensed postage charge can be determined is to perform the accounting at the time of each franking operation.

Secondly, *Herring* requires (see, for example, column 3, lines 55 to 61) that a calculation be performed in each franking operation to determine whether the sum of the required postage charge and the accumulated total value of postage charges is equal to or less than the accumulated total value of credit, and the franking operation can only continue if the sum of the required postage charge and the accumulated total value of postage charges is equal to or less than the accumulated total value of credit. Inasmuch as this calculation is an essential requirement of the method and apparatus of *Herring*, deferral of the accounting, as suggested by the Examiner, would be entirely contrary to the teaching of *Herring* and would actually render the method and apparatus inoperative or unsatisfactory. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

Thirdly, in accounting for the dispensed postage charge in each franking operation, *Herring* requires only that a single tote register be updated (see, for example, column 3, lines 52 to 54 and column 3, line 67 to column 4, line 4), the credit register remaining unchanged. In this regard, if the suggestion by the Examiner is that modifying the method and apparatus of *Herring* in accordance with the teaching

of *Herring* would avoid the need for a complex, contemporaneous accounting function, the accounting function in the method and apparatus of *Herring* could not already be any simpler, as it requires only the updating of a single, tote register. And, as mentioned above, the updating of this tote register is an absolutely essential requirement of *Herring*.

Notwithstanding that a person skilled in the art would not have contemplated the information which is downloaded nightly to be a batch of mail items in the sense as required by the claimed invention, claim 14 specifically requires (a) the storing of an accumulated pending value in respect of any uncompleted batches, and (b) the decrementing of that value only on the completion of any batch. Apparatus claim 23 contains similar limitations.

Even if the Examiner's interpretation of *DirecTV* – that the programming purchase information, which is downloaded nightly, constitutes a batch – the system of *DirecTV* could only maintain an accumulated pending value in respect of a single batch. Such an interpretation does not provide for operation in relation to a plurality of batches as does the claimed invention.

In marked contrast to the claimed invention, in which the accumulated pending value is retained in respect of any uncompleted batches, the system of *DirecTV* provides for the nightly downloading of all programming purchase information, and makes no distinction between the entries in the downloaded information as being uncompleted or completed.

In summary, we submit claims 14 and 23 patentably distinguish the combined disclosures of *Herring* and *DirecTV*, and that the rejection of the claims ought to be reversed.

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March 23, 2005

## APPENDIX -- CLAIMS ON APPEAL

14. A method of accounting for postage charges in respect of batches of mail items, said method including steps of:

storing an accumulated aggregate value of postage dispensed in applying postage charges to mail items;

storing an accumulated pending value of postage dispensed in applying postage charges to mail items of any uncompleted batches of mail items; and

in response to completion of one batch of mail items, decrementing the accumulated pending value by a value of postage relating to the one completed batch of mail items.

15. A method as claimed in claim 14, wherein the step of storing the accumulated pending value includes the step of:

storing an accumulated pending value of postage dispensed in applying postage charges to mail items of the one uncompleted batch of mail items and postage charges to further mail items of at least one further uncompleted batch of mail items.

16. A method as claimed in claim 14, wherein the accumulated aggregate value comprises postage dispensed on mail items of the one completed batch of mail items and postage dispensed on mail items of at least one further uncompleted batch of mail items.

17. A method as claimed in claim 14, wherein the accumulated aggregate value consists only of the postage dispensed in respect of mail items of completed batches of mail items.

18. A method as claimed in claim 17, including the step of:

incrementing the accumulated aggregate value by the value of postage relating to the one batch of mail items in response to completion of the same.

19. A method as claimed in claim 14, wherein the value of postage relating to the one completed batch of mail items is the postage dispensed in respect of the one completed batch of mail items.

20. A method as claimed in claim 14, further including the steps of:

receiving a message from a mail handling authority in respect of the one completed batch of mail items; and

decrementing the accumulated pending value by a value of postage relating to the one completed batch of mail items.

21. A method as claimed in claim 20, wherein the message includes an indication of an amount of postage charge determined by the mail handling authority to be due on the one completed batch of mail items, and the value of postage relating to the one completed batch of mail items is the amount of postage charge indicated in the message.

22. A method as claimed in claim 14, including the step of:

utilizing the accumulated aggregate value and the accumulated pending value to determine a payment due in respect of postage charges.

23. Apparatus for accounting for postage charges in respect of batches of mail items, including:

a first memory storing an accumulated aggregate value of postage dispensed in applying postage charges to mail items;

a second memory storing an accumulated pending value of postage dispensed in applying postage charges to mail items of at least one uncompleted batch of mail items; and

accounting means operable in response to completion of one batch of mail items to decrement the accumulated pending value by a value of postage relating to the one completed batch of mail items.

24. Apparatus as claimed in claim 23, wherein the first memory stores an accumulated aggregate value of postage dispensed in applying postage charges to mail items of completed batches of mail items and postage charges to mail items of the one uncompleted batch of mail items.

25. Apparatus as claimed in claim 23, wherein the first memory stores an accumulated aggregate value of postage dispensed in applying postage charges to mail items to completed batches of mail items.

26. Apparatus as claimed in claim 25, wherein the accounting means is operable in response to completion of the one batch of mail items to increment the first memory by the value of postage dispensed in respect of the one completed batch of mail items.